

Appl. No. 09/844,161
Amdt. Dated 05/25/2006
Reply to Final Office Action of March 30, 2006

REMARKS

This Amendment is in response to the Office Action mailed March 30, 2006. In the Office Action, claims 23(a)-25 were incorrectly numbered with repetitive claim "23" references. Claims 6-8 were rejected under 35 U.S.C. §112 (second paragraph) and claims 1-8, 13-14 and 20-25 were rejected under 35 U.S.C. §103(a). Herein, claims 23-25 have been correctly renumbered as claims 23-26 and dependency of claims 25 and 26 have been amended. Withdrawal of the objection associated with claims 23(a)-25 is respectfully requested.

Request for Examiner's Interview

The Examiner is respectfully requested to contact the undersigned attorney below if after review, such claims are still not in condition for allowance. This telephone conference could greatly facilitate the examination of the present application. The undersigned attorney can be reached at the telephone number listed below.

Rejection Under 35 U.S.C. § 112

Claims 6-8 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicant respectfully traverses the rejection because claim 6 includes the limitation "said recording station" since the "recording station" is set forth in independent claim 1. Therefore, there is sufficient antecedent basis for this limitation. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 112 (second paragraph) as applied to claims 6-8 as applied.

Rejection Under 35 U.S.C. § 103

Claims -8, 13-14 and 20-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Brewer (publication entitled "Intelligent Tracking in Manufacturing") in view of Morimoto (publication entitled "Digital Watermarking Technology with Practical Applications"). Applicant respectfully traverses the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988).* Herein, the combined teachings of the cited references fail to provide any suggestion or motivation for such combination. Reconsideration is respectfully requested.

As the Examiner is aware, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir.*

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1990). Applicants respectfully submit that none of the cited references suggest such combination, and in fact, such combination constitutes impermissible hindsight reconstruction.

Presuming the combination of Brewer and Morimoto is deemed permissible, and none of these references constitute non-analogous art, the combination does not render the claimed invention unpatentable. Brewer is directed to the use of radio frequency identification (RFID) in combination with global positioning system (GPS) in order to improve supply chain efficiency. Morimoto is directed to digital watermarking, which offers the content owners the opportunity to detect unauthorized use and to trace the origination of such unauthorized use. None of these references provide any suggestion or motivation to combine tracking technology such as RFID with recording technology such as digital watermarking. In general, both publications are directed to different technologies to solve different problems.

As aptly stated by the Federal Circuit in *In re Kotzab*, 217 F.3d 1365, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000), "to establish obviousness based on a combination of the elements disclosed in the prior art, *there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant.*" Emphasis added. Herein, Applicant respectfully submits that none of these references provide such motivation, and thus, respectfully requests the Examiner to withdraw the §103(a) rejection.

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Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: May 25, 2006

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Susan McFarlane

5/25/2006

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